

### **REMARKS**

Claims 1-13 and 35-50 are now pending in the application. Claims 14-34 have been cancelled. Minor non-narrowing amendments have been made to the specification and claims to simply overcome the objections to the specification and rejections of the claims under 35 U.S.C. § 112. The amendments to the claims contained herein are intended to broaden the scope thereof and/or are of equivalent scope as originally filed and, thus, are not a narrowing amendment. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

Applicants hereby request an interview with the Examiner to discuss the Amendment herein in light of the concurrently filed Declaration under 37 C.F.R. § 1.131 and the status of the cited art. Applicants request that the Examiner contact Applicants' representative at Examiner's earliest convenience and prior to mailing any further office actions.

### **ELECTION/RESTRICTION**

Applicants reiterate the traversal of the election/restriction requirement imposed on the present application, although Applicants have elected to have Claims 1-13 and 35-44 initially examined in relation to the species illustrated in Figure 1. Further, because the restriction requirement has been made final, Applicants reserve the right to petition the Director to amend the restriction requirement.

## **SPECIFICATION**

The specification stands objected to for certain informalities. In the Office Action, it is noted that proper antecedent basis is required for the subject matter in the claims. Although the Office Action only gives two examples, such as first member and second member, Applicants respectfully assert that there is clear support for such terms in the description as filed. Applicants submit that one skilled in the art will understand the terms in the claims and such understanding is clear in that the claims using such terms have been rejected based upon cited art.

The exemplary language “first member and second member”, which appears to be taken from independent Claim 35, has abundant support in the specification as filed. Independent Claim 35 recites “a first member including an internal concave portion defining an internal concave diameter”. From review of the specification as filed and the drawings as filed, one skilled in the art could understand what is meant by a first member.

Applicants respectfully assert that Applicants are not required to use the exact terms from the specification, particularly because they are in the claims as filed, but they only need to be clearly understood from the specification as filed. Further, Applicants note that the claims form a part of the specification as filed and the objected to terms were used in the claims as filed, therefore, clear antecedent basis is provided for each of the terms in the presently pending claims because they include language that is identical to the claims as filed.

Therefore, Applicants respectfully request that the Examiner withdraw the objection to the specification or specifically point out those terms in the claims that are not clearly understood by reference to the specification as filed.

### **REJECTION UNDER 35 U.S.C. § 112**

Claims 35-37 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

Minor non-narrowing amendments have been made to Claim 35 to overcome this rejection. Therefore, Applicant requests that this rejection be withdrawn.

### **REJECTION UNDER 35 U.S.C. § 102 AND §103**

Claims 35-44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Donner (U.S. Patent No. 3,003,339). Claims 1, 10-13, 35-44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Graf (WO 02/00141). Claims 1-2 and 10-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gray, III (U.S. Patent No. 5,800,555). Claims 1-13 and 35-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Noiles (U.S. Pat. No. 4,978,356) in view of Graf (U.S. Pat. No. WO 02/00141). These rejections are respectfully traversed.

Applicants submit that the present application properly claims priority to the provisional application, Serial No. 60/413,239, that was filed on September 24, 2002. Therefore, the effective filing date of the present application is September 24, 2002. Graf, which was filed and published in French under the Patent Cooperation Treaty (PCT), was published January 3, 2002. There does not appear to be any U.S. equivalent of the Graf application. Therefore, Applicants submit that Graf is improperly used to reject various claims under 35 U.S.C. § 102(b). Graf, at best, would be a prior

art reference under 35 U.S.C. § 102(a) as being an application published by another. Therefore, Applicants submit that Applicants can provide facts to prove earlier conception and/or reduction to practice of the presently claimed invention. To that end, regarding publication WO 02/00141 to Graf, Applicants have concurrently filed a declaration under 37 C.F.R. § 1.131.

In the Declaration, facts are asserted and evidence provided to show prior conception and/or reduction to practice of the presently claimed invention prior to the publication date, January 3, 2002, of the Graf reference. Therefore, Applicants submit that the Graf reference is not prior art to the presently pending claims.

Although Applicants have submitted the Declaration under 37 C.F.R. § 1.131 to expedite prosecution of the subject Application, Applicants submit that the presently pending claims are in condition for allowance in light of Graf. While Applicants do not currently have an English translation of the Graf reference, the Graf reference appears to disclose a system which requires a set screw to maintain a connection between a first portion and a second portion. The system includes a fixed element 12 to be fixed to a bone and an intermediate member 20 to allow for articulation. The intermediate element 20 appears to have at least one degree of freedom relative to the fixed element 12 and the immobile element 4 also has freedom of movement relative to the intermediate member. Therefore, the reference to Graf does not appear to teach or fairly suggest each of the elements of the presently pending claims.

With regard to Donner, Applicants respectfully disagree that Donner teaches each of the elements of independent Claims 35 or 39, or each of the claims that depend directly or indirectly therefrom. Donner specifically teaches a "Lockage of breach of

mortar barrel to a counterplate". The socket 8 is welded to a counterplate and allows for fixation of a inside spherical surface 9 with a ball joint part 3. Therefore, Donner does not teach or fairly suggest a prosthesis. Contrary to this, independent Claim 35 recites "a prosthetic joint for replacement of a natural joint . . . a first prosthesis member . . . a second prosthesis member". Independent Claim 39 recites "a prosthesis for replacement of an anatomical portion, comprising: a first prosthesis member . . . a second prosthesis member". Therefore, Donner does not teach or fairly suggest each of the elements of independent Claims 35 and 39 as Donner does not teach or fairly suggest a prosthesis. Moreover, Donner actually teaches away from a prosthesis by requiring fastening the joint sockets to a counterplate such as by welding. No counterplate would be possible in a prosthesis to replace a joint.

Gray, III is directed to an acetabular cup-bearing liner that can include a ball 78 that can be inserted into a bearing liner 14. The bearing liner 14 has sufficient flexibility to allow for elastic deformation of the first annular extension 64 to allow for entry of an inelastic ball 78. (See col. 4, Ins. 15-20.) This allows the securing ring 68 to be positioned after inserting the ball 78 to assist in holding the ball 78 from dislocation. Therefore, Gray, III specifically teaches that the ball must deform the liner to allow for insertion of the ball into the liner. Therefore, Gray, III does not teach or fairly suggest "a liner including an internal concave portion . . . a ball portion having a ball with a diameter substantially equal to said internal concave diameter . . . wherein said ball portion includes an equator having an equator diameter similar to said passage width and smaller than said ball diameter". In other words, Gray, III has and requires that every portion of the ball 78 be larger than the liner.

The combination of Noiles and Graf is further improper as Graf is not prior art to the present claims. The Office Action notes at least one deficiency in Noiles as compared to the presently pending claims. Applicants submit, however, that numerous elements in the presently pending claims are not taught or fairly suggested by Noiles and no cited combination could cure this deficiency. For example, independent Claim 1 recites "wherein said ball portion includes an equator having an equator diameter similar to said passage width and smaller than said ball diameter". Independent Claim 35 recites "a second prosthesis member having a selected diameter and defining at least one cylindrical portion about at least a portion of a selected equator of said second prosthesis member."


Applicants submit that each of the presently pending rejections to the claims have been overcome or rendered moot by the amendments or arguments included herein. Therefore, Applicants request that the Examiner allow each of the presently pending claims.

## CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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